

REMARKS

Claims 1 and 3-19, as amended, and new claim 20 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1 and 14 have been rewritten to recite subject matter indicated to be allowable by the Examiner. Accordingly, claim 2 has been canceled and claims 3-4 have been amended to maintain consistency with the amended language now recited in independent claim 1. In addition, new claim 20 has been added to recite an additional embodiment of the invention that is fully supported by the Written Description.

As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

LINED OUT REFERENCES AND IDS

Applicants submit herewith an Information Disclosure Statement to inform the Office of a pending litigation involving parent U.S. Patent No. 6,818,705 to Wu *et al.*, in which the assignee has alleged infringement of the claims of the '705 patent against Bridgestone Sports Co., Ltd.

With regard to the lined-out references on the returned Form PTO-1449 (submitted with the IDS filed May 19, 2004), Applicants submit a current form PTO-1449 listing the lined out references and accounting for any errors in the previous Form PTO-1449. Copies of these reference are submitted herewith.

THE REJECTIONS UNDER 35 U.S.C. § 103

Claims 1 and 5-19 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,315,684 to Binette *et al.* in view of U.S. Patent No. 3,989,568 to Isaac, U.S. Patent No. 4,123,061 to Dusbiber, U.S. Patent No. 6,309,313 to Peter, or U.S. Patent No. 6,190,268 to Dewanjee for the reasons stated on pages 2-3 of the Office Action.

As recognized the Examiner, none of the references disclose or suggest the present invention now recited. In particular, Binette lacks the inclusion of a cis-to-trans catalyst. While Binette does generally disclose the use of cobalt and neodymium catalysts, those of ordinary skill in

the art are aware that these types of catalysts are not used to convert cis-isomer to trans-isomer, but instead are used to improve the processability of the ultra-high Mooney viscosity polybutadienes. *See, e.g.*, Col. 4, lines 56-58. In addition, as stated by the Examiner, Binette does not disclose or suggest any details of the polyurethane cover formulation.

In an attempt to remedy the deficiencies of the primary reference, the Examiner cites the secondary references for their respective disclosures of polyurethane covers. Office Action at Pages 2-3. None of these references, however, cure the deficiency of Binette with regard to the core formulation presently recited.

In light of the explanation above, Applicants respectfully submit that none of the cited references disclose or suggest the present invention. Consequently, Applicants respectfully request reconsideration and withdrawal of the rejections based thereon.

THE DOUBLE PATENTING REJECTION

The Examiner rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1-19 of U.S. Patent No. 6,818,724 to Wu *et al.* and claims 1-50 of U.S. Patent No. 6,486,261 to Wu *et al.*. Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) in order to overcome the double patenting rejections based on the '724 and '261 patents. In light of the Terminal Disclaimer, Applicants respectfully submit that the double patenting rejection is overcome.

In addition, claims 1-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on co-pending U.S. Patent Application No. 10/238,729. Applicants respectfully submit that the '729 application issued on November 16, 2004 as the aforementioned '724 patent. As such, Applicants respectfully submit that the double patenting rejection based on the '729 application is duplicative and, thus, request reconsideration and withdrawal thereof.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response two months to and including March 20, 2006 (since the due date of March 18, 2006 falls on a Saturday). A Fee Sheet Transmittal is submitted to pay for this extension, the Terminal Disclaimer, and the Information Disclosure Statement.

No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0395.

Respectfully submitted,
BINGHAM MCCUTCHEN LLP

Dated: March 20, 2006

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